IN THE

Supreme Court of the United States

OCTOBER TERM, 1943.

No. 897

HENRY I. WARDEN,
Petitioner,

vs.

CITY OF ST. LOUIS, MISSOURI,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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THE TWENTIETH CENTURY PRESS, INC., CHICAGO

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PETITION.

To the Honorable, the Chief Justice, and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Henry I. Warden, respectfully prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Eighth Circuit to review a decree of that court entered February 14, 1944 (R. 321) affirming a decree of the District Court of the United States for the Eastern District of Missouri (R. 306). A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, together with the necessary additional copies thereof, has been filed in compliance with Rule 38 of the rules of this Court.

Summary and Short Statement of the Matter Involved.

This is a patent infringement suit brought by the petitioner against the City of St. Louis, Missouri, in which the District Court entered a judgment of dismissal on the ground of invalidity of the claim sued upon (R. 306), the judgment being affirmed by the Court of Appeals (R. 321).

The District Court did not file an opinion but, in compliance with Rule 52 of the Federal Rules of Civil Procedure, entered Findings of Fact and Conclusions of Law (R. 303-306). The opinion of the Court of Appeals is at pages 315-321 of the record.

Petitioner is the patentee and owner of United States Letters Patent No. 1,955,569, issued April 17, 1934 (R. 42). A patent being originally refused by the Patent Office, Warden filed an action (R. 265) against the Commissioner pursuant to § 4915 of the Revised Statutes (35 U. S. C. § 63) in the United States District Court for the District of Columbia and there obtained the adjudication of Mr. Justice Bailey that he was entitled to a patent containing the claims which now appear in it (R. 281).

The title of the patent is "Licensing of Motor Vehicles" and it relates to a license tag for motor vehicles in the form of a frangible film, such as a decalcomania, which by reason of its frangibility cannot be removed without destruction or without leaving permanent evidence of its removal. Warden was concerned with the problem of preventing the theft of automobile license tags and their unauthorized transfer from one vehicle to another.

The patent contains four claims, of which only Claim 3 is involved in this suit. That claim reads as follows:

> "A license tag for a motor vehicle, comprising a frangible film, provided with identifying serial numerals, and adapted to be secured to a glass part of the motor vehicle against removal without destruction."

The accused device is the wheel tax license sticker issued by the City of St. Louis in 1940, which license tag is in the form of a commercial decalcomania bearing a serial number on the face thereof (R. 303, Finding of Fact No. 7). With reference to the identity of the accused device with the patented invention, the Court of Appeals said: "it is apparent that the city has substantially adopted Warden's plan for licensing automobiles" (R. 318).

The essential facts necessary for consideration in connection with the questions presented are succinctly stated in the opinion of the Court of Appeals. Briefly, they are as follows:

Warden made his invention in 1931. For ten years prior thereto, the City of Chicago had been issuing metal license discs as evidence of the payment of the annual city tax on automobiles, the said discs being about 5 inches in diameter and being bolted to a corner of the usual State license tag carried by the vehicle. These discs could be removed without difficulty, thus giving rise to a theft and fraud problem resulting in annoyance and expense to those whose discs were stolen and in loss of revenue to the City (R. 316).

The problem of the theft and unlawful transfer of these license discs in Chicago was a serious one. The officials whose duty it was to collect the tax on automobiles were aware of the problem and were trying to solve it but failed to arrive at a satisfactory solution (R. 316). Duplicate discs were required to be furnished at a small charge, and these comprised, on the average, as many as 4% of the number of original discs issued annually during the ten years from 1921 to 1931. Prosecutions by the City growing out of the stealing of such discs during that ten-year period were an every-day occurrence (R. 316).

In 1931, Warden, who had thrice been the victim of thieves who stole his license discs from his car, conceived

the idea of a license tag in the form of a decalcomania or sticker to be placed on the windshield, which could not be removed without destruction and which, therefore, would prevent the theft of the license tag (R. 317). He communicated his idea to the officials of Chicago and an ordinance was immediately passed putting his idea into effect (R. 317).

As the result of the adoption of Warden's license tag, the City of Chicago, during the first month of operation under Warden's system, collected an additional revenue of approximately $250,000 over prior years. Since then, the number of duplicates issued has become negligible, as have also prosecutions for the theft of license tags (R. 317).

Suits for infringement against the City of Chicago and against Kansas City, Missouri, were terminated by consent decrees entered into by the suppliers of the infringing license tags (R. 317). Large manufacturers of decalcomanias have taken licenses under the patent in suit (R. 317). At the time of trial, about 150 villages and cities were licensed users of Warden's patented tag (R. 318).

The Court of Appeals, having first expressed the view that it was unnecessary "to analyze the prior art in detail" (R. 319), summarized its view of the case as follows:

> "What Warden discovered was that a license tag or sticker consisting of a decalcomania or other frangible film attached to the windshield of an automobile was an economical and effective method of preventing the theft and unlawful transfer of automobile licenses. The discovery was a meritorious one, met with commercial success, and solved a long existing problem. The simplicity of the device which solved the problem should not militate against patentability if, in fact, invention was involved."

Because certain paper insurance certificates had previously been put on the windshields of taxicabs, the court answered the question of invention by saying:

"The conception that a frangible film license sticker would more adequately serve the purpose than a paper one, could not, we think, reasonably be regarded as the product of inventive genius" (R. 321).

Decalcomanias, as such, were concededly old before Warden made the invention in issue. Because patents on such decalcomanias had expired, the Court concluded that "the invention, for any and all purposes for which it is adapted, becomes public property and can be used by any one" (R. 320).

Questions Presented.

1. When a court has found that a patentee has made a meritorious discovery which is an effective and economical solution of a long-existing and well-recognized problem, which others had failed to solve, and that his solution has commended itself to the public as evidenced by its prompt adoption and commercial success, may the court ignore these accepted indicia of invention and, disregarding the established law, conclude that the discovery resulted from the exercise of mere mechanical skill?

2. When a patentee has created out of an old material a new device in which a known characteristic of the old material is so utilized for the first time as to enable the device made therefrom to serve a new and useful purpose, is the patent invalid under the doctrine of *Roberts* v. *Ryer*, 91 U. S. 150, which is to the effect that the inventor of a machine (here, the material) is entitled to the benefit of all uses to which it can be put, whether he knew of them or not?

Reason Relied Upon For the Grant of a Writ of Certiorari.

In urging the Court to grant the writ, petitioner desires to make it clear that he is not asking a retrial of the facts

but only a proper application of the law to the facts as found below.

The discretionary power of this Court is invoked upon the following grounds:

1. The Circuit Court of Appeals for the Eighth Circuit has decided important questions of Federal law in a manner which is believed to be untenable and in direct conflict with the applicable decisions of this Court.

2. The Circuit Court of Appeals for the Eighth Circuit has decided important questions of Federal law, the effect of which is of great public importance and concern because the patent in suit is of great and peculiarly direct public interest in that it has enabled the tax collectors of cities, towns and villages throughout the entire country more completely to perform their duties and thus more equitably to distribute the tax burden among the taxpayers.

WHEREFOR your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Court directed to the United States Circuit Court of Appeals for the Eighth Judicial Circuit, commanding said court to certify and send to this Court, on a day to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in this case, to the end that this case may be reviewed and determined by this Court; that the judgment of the Court of Appeals for the Eighth Circuit be reversed, and that petitioner be granted such other and further relief as may to this Court seem proper.

HAROLD OLSEN,
Counsel for Petitioner.

Dated: Chicago, Illinois, April 15, 1944.